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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of	Docket No.: P26995
C. L. BATES, *et al.*	Confirmation No.: 7213
Serial No.: 09/827,233	Group Art Unit: No. 2143
Filed: April 5, 2001	Examiner: J. C. Pwu

For: **METHOD AND COMPUTER PROGRAM PRODUCT FOR PROVIDING EMAIL THAT GUIDES A RECIPIENT THROUGH A SET OF ASSOCIATED WEB PAGES**

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop <u>AF</u>
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of October 19, 2005.

Reconsideration and withdrawal of the single 35 U.S.C. § 102(e) rejection and the single 35 U.S.C. § 103(a) rejection is respectfully requested in view of the following remarks.

A prima facie case of anticipation has not been set forth and the Rejection Under 35 U.S.C. § 102(e) Is Improper. A prima facie case of unpatentability has also not been set forth and the Rejection Under 35 U.S.C. § 103(a) Is Improper

Examiner's Assertion

In support of the anticipation rejection, the Examiner asserts that GUPTA discloses each and every feature of at least independent claims 1-3 such as that the sent email includes a preferred viewing order of URLs or web pages identified by the URLs.

Applicants' Response

Applicants respectfully disagree. GUTPA does not disclose or even suggest, among other things recited in at least claims 1-3, that the sent email includes a preferred viewing order of URLs or web pages identified by the URLs, much less,

- 1 -

generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order.

While the Examiner has identified steps 402-408 of GUPTA as disclosing these features, Applicants submit that these steps simply do not disclose the recited preferred viewing order of web pages. For example, step 402 (which is the first step) occurs after the e-mail is sent to the recipient, i.e., this step is labeled "Receive Email Message". As a result, it cannot properly be said that such steps disclose, or even suggest, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient.

The Examiner has also identified steps 402-408 as disclosing the generating, in response to input of the originator, of a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order, a fair review of description describing these steps demonstrates otherwise. Paragraph [0123] of GUPTA, for example, states:

> [0123] Initially, the annotation server receives an email message with annotation content (step 402). The annotation server analyzes the email message and locates the annotation data in the email message (step 404), generating at least one new annotation from the annotation data in the email message (step 406). The number of annotations generated can vary (e.g., depending on whether the email message is an email thread).

It is clear from such language that while GUPTA discloses receiving "an email message with annotation content", such language does not disclose that the annotation or annotation content includes a preferred viewing order. Nor does this language disclose, or even suggest generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform

resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order.

Furthermore, while the Examiner has alleged that GUPTA somehow discloses a preferred viewing order of web pages or URLs (see page 6 of the Final Office Action), the Examiner has failed to identify any such language in GUPTA. Nor are Applicants persuaded by the Examiner's identification of certain language (apparently located on paragraph [0085]) (see page 6 of the Final Office Action). While this language indicates that a group of entries can be made into the e-mail, the noted entries relate to e-mail addresses and not to URLs or web pages.

The Examiner also asserts that Applicants have not sufficiently defined the preferred viewing order and that such language is therefore disclosed by a preferred viewing order of e-mail addresses (see page 6 of the Final Office Action). This assertion is without merit. Claim 1, for example, clearly recites <u>a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient</u>. Such language clearly defines the preferred viewing order as one of <u>web pages</u> identified by the plurality of URLs and not e-mail addressed.

Additionally, while it is true that GUTPA discloses that a user can select a "host identifier 306 in email message 302" and that "temporal range information is forwarded to media server 11" such that "[m]edia server then begins streaming the media content to client 15" (see paragraph [0099]), it is clear that this language does not disclose or even suggest that the sent email includes a preferred viewing order, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient, and/or displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed, wherein the preferred viewing order is included in the navigation, and/or generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators

that identify web pages to be viewed by the recipient in a preferred viewing order.

Applicants also submit that the system in GUPTA is entirely different from that of Applicants' invention. Whereas the invention provides for the sending and/or receiving of emails which include a web page navigation having a preferred viewing order defined by the originator, GUPTA merely discloses that an email can be sent once the originator identifies a particular annotation.

Thus, Applicants respectfully submit that independent claims 1-3 are not disclosed, or even suggested, by any proper reading of GUPTA.

Examiner's Assertion

In support of the obviousness rejection, the Examiner acknowledges that GUTPA lacks, among other things recited in the above-noted claims, the recited colors, icons, and font characteristics. However, the Examiner explains that such features are taught by KOMURO and that it would have been obvious to combine the teachings of these documents.

Applicants' Response

Applicants respectfully disagree. As explained above, GUPTA is entirely silent with regard to sending an email that includes a preferred viewing order of web pages, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order.

KOMURO, however, does not cure the deficiencies of GUPTA. KOMURO is also entirely silent with regard to sending an email that includes a preferred viewing order of web pages, much less, generating, in response to input of the originator, a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order. Indeed, while the Examiner has identified a number of paragraphs in KOMURO as disclosing the language acknowledged to be missing in GUPTA, it is clear from a fair reading of KOMURO that this document merely discloses the updating of a web page when a particular URL is displayed a number of times.

In particular, paragraph [0035] of KOMURO merely states the following:

[0035] When a URL is not yet registered in the definition management note 18 or the number of times of display has not reached the degree of importance, the

WWW browser functioning unit 13 displays the down-loaded web page "as is." If the number of times of display reaches a degree of importance, such Web page is updated to be a Web page in which a degree of importance mark is given to the associated URL. In this case, registration of the URL to the bookmark is defined, such that the importance degree control unit 15 calls the automatic registration control unit 17 to automatically register the relevant URL to bookmark 19. Moreover, the automatic registration control unit 17 may call the automatic page generating unit 24 to automatically generate the Web page from the URL information in bookmark 19. The WWW browser functioning unit 13 displays each page depending on the updated definition management note 18.
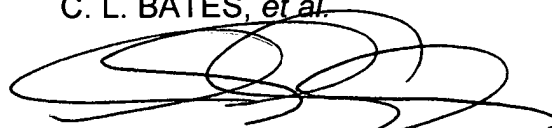
Furthermore, each of independent claims 8, 9, 10, 11 and 16 claims recite, among other things, an email and/or a navigation which includes a preferred viewing order of web pages. On the other hand, as noted above, GUPTA fails to disclose or suggest a preferred viewing order of web pages, much less, the sending of an email which includes, among other things, a preferred viewing order of web pages. Moreover, KOMURO merely discloses the updating of a web page when a particular URL is displayed a number of times (see paragraph [0035] of KOMURO above). Thus, KOMURO also simply fails to disclose or suggest a preferred viewing order of web pages, much less, the sending of an email which includes, among other things, a preferred viewing order of web pages. Nor has the Examiner demonstrated otherwise.

Finally, Applicants submit that there is no motivation to combine the above-noted documents at least because KOMURO fails to cures the deficiencies of GUPTA.

<u>CONCLUSION</u>

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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